

REMARKS

Claims 1, 4-9, 11-23, 25-28, 76-77, and 142-163 are currently pending in the above-identified patent application. Claims 1, 4-9, 11-14 and 26-28 are allowed. Claims 142-151 are canceled by this amendment. Reconsideration of the rejections in light of the present arguments and amended claims is respectfully requested.

I. Rejection under 35 U.S.C. §112, 1st paragraph:

Claims 15-23, 25, 76-77, and 142-163 are presently rejected under §112, 1st paragraph as allegedly lacking compliance with the written description requirement. Specifically, Examiner held claims 15, 16, 76, 142 and 148 were amended to include new limitations, which included matter without adequate support in the specification.

Applicant respectfully requests Examiner withdraw the rejection as applied to the above-identified claims. Applicant submits the rejection is obviated as applied to claims 142-151, as these claims are canceled by way of amendment.

Therefore, Applicant presents arguments for withdrawal of this rejection, as applied to claims 15-23, 25, 76-77 and 152-163.

With respect to claims 15-23, Applicant respectfully requests clarification surrounding claims 17-23 and 25. Examiner stated that claims 17-23 and 25 are included in this rejection "because they are dependent claims that

encompass all of the embodiments of the independent claims, including the limitations which are new matter." (Paper mailed November 28, 2006, p. 5) Claim 17, in fact, is an independent claim, on which claims 18-23 and 25 depend. Furthermore, claim 17 now recites an encoded polypeptide with a specific function; one that inhibits apoptosis. This was the requirement necessary to satisfy the §112, 1st paragraph rejection. (See Paper mailed March 7, 2006, page 5) Accordingly, Applicant respectfully requests the withdrawal of the present rejection with respect to claims 17-23 and 25, as the alleged new matter regarding the nucleic acid sequence ranges are not contained therein.

Similarly, claims 152-163, as currently amended, recite the limitations of allowed claim 1 rather than canceled claim 142. As such, Applicant respectfully requests withdrawal of this rejection as applied to claims 152-163.

Finally, Applicant respectfully submits the present amendments to claims 15 and 16 obviate the rejection under §112, 1st paragraph. Claim 15 now clearly recites the sequence that hybridizes to SEQ ID NO: 1 is the entire length of said SEQ ID NO: 1. Support for this clarifying amendment can be found at page 30, paragraph 4. Additionally, dependent claim 16 recites markush language wherein the hybridizing sequence may be one of several fragments, the ranges of which are all taught within the instant specification; most notably, at page 30, paragraph 4.

Examiner has previously cited In re Ruschig for the proposition that one cannot disclose a forest in the specification, and then claim a tree as the invention. However, Applicant respectfully submits the more appropriate case of In re Wertheim for guidance relative to inventive claims within disclosed ranges. (See In re Wertheim, 191 U.S.P.Q. 90 (C.C.P.A. 1976)) In re Ruschig would be applicable if, for example, Applicant selected, out of a range of 500-1000 base pairs, a single base pair at location 652. This is what In re Ruschig was meant to preclude; in this example, disclosing the forest (500-1000 base pairs) and selecting a tree as the invention (the base pair at 652).

The general rule of In re Wertheim is that a narrower range that is completely within a range explicitly provided in the specification can be recited in a claim (claimed ranges between 35%-60% held allowable, even though specification disclosed explicit range of 25%-60%). Such a narrower range is in compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112 and does not constitute new matter. There is no requirement in statute or case law that every intermediate value within the originally-disclosed range needs to be recited explicitly in the specification in order for such an intermediate value to be recited in a claim (See, additionally, In re Blaser, 194 U.S.P.Q. 122 (C.C.P.A. 1977), where claims reciting the temperature range of 80%-200% were allowed, even though specification disclosed broader range of 60%-200%)

Claim 16 has a recitation of a narrower range (701-1000 base pairs) which is fully supported by the broader range disclosed in the specification (500-1000 base pairs). Applicant respectfully submits the recitation in the claims of a narrower range relative to that range explicitly disclosed in the specification is not new matter and not properly subject to a rejection under the under the written description requirement of 35 U.S.C. §112, 1st paragraph.

Similarly, Applicant has obviated this rejection, as it applies to claims 76-77, by way of amendment. Specifically, claims 76-77 now recite an encoded polypeptide with a specific function; one that inhibits apoptosis. This was the requirement necessary to satisfy the §112, 1st paragraph rejection. (See Paper mailed March 7, 2006, page 5)

In light of the above remarks, Applicant respectfully submits that the rejections under 35 U.S.C. §112, first paragraph have been addressed, and respectfully requests that the Examiner withdraw these rejections and allow the claims.

II. Rejection under 35 U.S.C. §112, 2nd Paragraph:

Claims 76 and 77 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The claims now recite the nucleic acid sequence encoding the amino acid sequence is greater than 700 base pairs in length and the nucleic acid sequence encodes a polypeptide that inhibits apoptosis. These amendments have obviated

the outstanding rejection and Applicant respectfully requests withdrawal of same.

Applicant is thankful for the assistance provided by Examiner with respect to amendment suggestions. In view of the foregoing arguments and present amendments to the claims, Applicant submits all outstanding rejections have now been obviated. Accordingly, Applicant respectfully requests withdrawal of these rejections and allowance of the remaining claims. Applicant is filing this response concurrent with a petition for a two-month extension of time, along with the requisite fees. Examiner is invited to contact Applicant's representative directly at (858) 200-0586.

Respectfully submitted,

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David M. Kohn, Esq.
Reg. No. 53,150

CATALYST LAW GROUP, APC
9710 Scranton Road, Suite 170
San Diego, California 92121
(858) 450-0099
(858) 450-9834 (Fax)